REMARKS

Claims 1-27 are pending in this application. Claims 28-51 have been cancelled by this Amendment as being drawn to a non-elected invention.

The Office Action dated December 16, 2004 rejected claims 1, 3, 8 and 10 as being anticipated by prior art. The Office Action rejected claims 2, 4, 5, 7, 9, 11 and 13 as being obvious in view of a first prior art and rejected claims 14 and 21 as being obvious in view of a second prior art. The Office Action also rejected claims 6, 12, 15-20 and 22-27 as being obvious over a combination of prior arts.

Claims 1, 3, 8 and 10

The grounds for the anticipation rejection of claims 1, 3, 8 and 10 is set forth in part 5 on pages 3-4 of the Office Action. Specifically, the rejection asserts that the claims are anticipated by the embodiment illustrated in Fig. 3 and described at col. 6 of U.S. Patent No. 6,085,069 issued to Sharpe (this embodiment hereinafter being referred to simply as "Sharpe"). Applicants respectfully traverse the rejection at least because it does not establish a prima facie case that Sharpe includes each and every one of the combination of features recited in the claims.

For example, independent claim 1 (claim 3 is dependent on claim 1) is directed to a method and recites the features of "storing persistently profile-specific information" in a profile-specific dictionary and "using the profile-specific dictionary for message compression." Independent claim 8 (claim 10 is dependent on claim 8) is directed to a system and recites substantially similar features.

The rejection cites the telephone numbers discussed at col. 6, lines 1-37, of the patent as showing that Sharpe includes the feature of "storing persistently profile-specific information in a profile-specific dictionary." The rejection also refers to the Abstract and to co. 6, lines 56-59, of the patent as showing that Sharpe includes "providing communication between the mobile station and the network station using the profile-specific dictionary for message compression."

The only information provided in Sharpe and discussed in the rejection is the telephone numbers. However, the telephone numbers are not profile-specific information. The telephone numbers are not directly related to the terminal itself, its capabilities, its identity, etc. The

9

Atty Docket No. 6173-5006

telephone numbers are merely used to designate the destination of phone calls. Specifically, Sharpe suggest that the stored telephone numbers be the "most used numbers that a pager user is required to contact" (see col. 6, line 13, of the patent).

Furthermore, in any event, there is no indication that the telephone numbers stored in Sharpe are stored in a dictionary that is used for compressing messages as is recited in claim 1. As described in column 6, lines 4-9 of the patent, the network controller and the pager each include a memory containing identical dictionaries. When sending an alpha-numeric message, dictionary references are transmitted wherever possible rather than the word itself encoded as ASCII characters.

Claims 3 and 10

Claims 3 and 10 are dependent on claims 1 and 8, respectively, and additionally recite that the profile-specific information comprises user information. The rejection apparently relies upon the telephone numbers in Sharpe, which are not user information for the reasons stated above.

Claim 2

The grounds for the obviousness rejection of claim 2 is set forth in part 7 on pages 5-6 of the Office Action. Specifically, the rejection asserts that the claims are obvious in view of Sharpe without citing any secondary reference.

Claim 2 is dependent on claim 1 and additionally recites that the profile-specific information stored persistently in the profile specific dictionary comprises device information. The rejection acknowledges that Sharpe does not include this feature, but asserts that it would have been obvious to modify Sharpe "to further include most frequently used device information such as its identity in the dictionary, for further improving the compression ratio of the message." Applicants respectfully traverse the rejection because it fails to point to any motivation in the prior art for making the proposed modification of Sharpe, and there would be no reason to do so except the hindsight provided by this application.

10

Claims 14 and 21

The grounds for the obviousness rejection of claims 14 and 21 is set forth in part 9 on pages 6-7 of the Office Action. Specifically, the rejection asserts that the claims are obvious in view of the method discussed in paragraphs 13-17 of European Patent Application No. 0933876 A1 filed by Bellovin (this method is hereinafter referred to simply as "Bellovin"). Applicants respectfully traverse the rejection because it fails to make a prima facie showing that a method having each and every one of the combination of features recited in the claims would have been obvious.

For example, independent claim 14 (claim 21 is dependent on claim 14) is directed to a method and recites "searching for a common dictionary based on [a setup message received from a mobile station]", "attempting to validate" the common dictionary when found, and "providing a common dictionary identifier associated with the common dictionary to the mobile station ..."

However, instead of searching for a common dictionary, in Bellovin, a fixed compression dictionary is sent by the mobile station during the start up of a communications session. In other words, the mobile station sending the setup message selects the dictionary. Consequently, searching for a common dictionary is unnecessary and is not performed in Bellovin. Although it is mentioned (see col. 4, lines 9 to 12, of the patent) that a pointer may be sent by the mobile station which identifies from where to retrieve the compression dictionary (instead of providing the dictionary), there still is no "searching" as recited in claim 14. The mobile station sending the dictionary or pointer has already selected an appropriate dictionary.
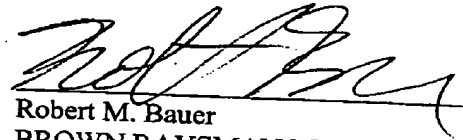
In Bellovin, there is also no attempt to validate a common dictionary as recited in claim 14. Since the mobile station has already selected the dictionary at startup, it is unnecessary to validate a dictionary. Similarly, since the mobile station has already selected the dictionary, Bellovin does not need to provide a common dictionary identifier associated with a common dictionary to the mobile station as recited in claim 14.

Applicants thus respectfully submit that claim 14 is allowable over Bellovin at least for the above reasons. Each one of claims 15-27 are also allowable at least for the same reasons as claim 14, as well as because of any of any additional features recited therein.

11

Atty Docket No. 6173-5006

The Commissioner of Patents is hereby authorized to charge any fees necessary for the consideration of this paper, or to credit any overpayment, to the undersigned attorney's Deposit Account No. 02-4270 (Atty. Docket 6173-5006US).

Respectfully submitted,

Robert M. Bauer
BROWN RAYSMAN MILLSTEIN
FELDER & STEINER LLP
900 Third Avenue
New York, New York 10022
Telephone: (212) 895-2000
Facsimile: (212) 895-2900

12